

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 620-358
C# M#

SPRINGER et al.

JUN 23 2006

TC/A.U.

1625

Serial No. 10/526,173

Examiner: Nagubandi

Filed: March 2, 2005

Date: June 23, 2006

Title: ENZYME ACTIVATED SELF-IMMOLATIVE N-SUBSTITUTED NITROGEN
MUSTARD PRODRUGSCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment 0 minus highest number
previously paid for 20 (at least 20) = 0 x \$50.00 \$0.00 (1202)/\$0.00 (2202) \$

Independent claims after amendment 0 minus highest number
previously paid for 3 (at least 3) = 0 x \$200.00 \$0.00 (1201)/\$0.00 (2201) \$

If proper multiple dependent claims now added for first time, (ignore improper); add
\$360.00 (1203)/\$180.00 (2203) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s)

One Month Extension \$120.00 (1251)/\$60.00 (2251)
Two Month Extensions \$450.00 (1252)/\$225.00 (2252)
Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)
Four Month Extensions \$1590.00 (1254)/\$795.00 (2254)
Five Month Extensions \$2160.00 (1255)/\$1080.00 (2255) \$

Terminal disclaimer enclosed, add \$130.00 (1814)/ \$65.00 (2814) \$

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee \$180.00 (1806) \$

Assignment Recording Fee \$40.00 (8021) \$

Other: \$

TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

901 North Glebe Road, 11th Floor
Arlington, Virginia 22203-1808
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NIXON & VANDERHYE P.C.
By Atty: B. J. Sadoff, Reg. No. 36,663

Signature: /B. J. Sadoff/



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SPRINGER et al.

Atty. Ref.: 620-358; Confirmation No. 6894

Appl. No. 10/526,173

TC/A.U. 1625

Filed: March 2, 2005

Examiner: Nagubandi

For: ENZYME ACTIVATED SELF-IMMOLATIVE N-SUBSTITUTED NITROGEN
MUSTARD PRODRUGS

* * * * *

June 23, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

Responsive to the Official Action dated May 23, 2006, the applicants elect, with traverse, the subject matter of the Examiner's Group I for further prosecution.

Reconsideration and withdrawal of the restriction requirement, and examination of all of the claims, are requested as, at a minimum, the Examiner's statement that the International Search Report

"indicates lack of unity of the invention and states that claim 1 is anticipated by Springer et al (WO 96/22277A1)"

is incorrect. To the extent the Examiner's restriction requirement is based on this misinterpretation of the International Search Report, the restriction requirement should be withdrawn.

The International Search Report dated December 18, 2003 issued in PCT/GB03/03736 indicates that Springer et al (WO 96/22277A1) is a Category "A" document (i.e., "document defining the general state of the art which is not considered to be of particular relevance"). The International Search Report does not indicate the existence of a lack of unity of invention and, as this appears to be the only asserted basis for the Examiner's restriction requirement, withdrawal of the restriction requirement and examination of all of the claims are requested.

For completeness, the applicants note that the International Search Report cites one "X" reference (i.e., "document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone"), which is also cited as a "P" reference (i.e., "document published prior to the international filing date but later than the priority date claimed"). That is, the category "X" reference of the International Search Report is antedated by the applicants priority document.

Withdrawal of the restriction requirement is requested.

For completeness, the applicants elect, with traverse, the "iodo" compound shown in claim 161. Claims 123-129, 132-157, 161 and 164 are believed to read on the elected species. Withdrawal of the species election requirement is requested as search and examination of all of the claimed subject matter is not believed to place an undue burden on the Examiner.

Withdrawal of the restriction and election of species requirements and an early and favorable Action on the merits of the claims is requested.

SPRINGER et al.
Appl. No. 10/526,173
June 23, 2006

Respectfully submitted,

NIXON & VANDERHYE P.C.

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